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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,434	01/24/2001	Jeffrey N. Sloan	M-9818 US	2388
33438	7590	01/07/2005	EXAMINER	
HAMILTON & TERRILE, LLP P.O. BOX 203518 AUSTIN, TX 78720			HAYES, JOHN W	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/768,434

Applicant(s)

SLOAN ET AL.

Examiner

John W Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Applicant amended claims 1, 4, 8, 11-12 and 14 in the amendment filed 04 October 2004. Thus claims 1-20 remain pending and are presented for examination.

Response to Arguments

2. Applicant's arguments with respect to the claims have been considered but are either not persuasive or moot in view of the new ground(s) of rejection.

3. With respect to claims 1 and 8, applicant's arguments are moot in view of the new grounds or rejection.

4. With respect to claim 4, applicant argues that Laor, Challener and Colligan, taken alone or in combination, do not teach or suggest a method for purchase verification which includes receiving a message at a server sent from the computer system, *the message including the service tag, verifying that the service tag value as received matches a service tag value stored in the server, and authorizing receipt of a benefit if the received service tag matches*. Examiner respectfully disagrees and notes that only the references to Challener et al and Colligan et al were used in the rejection of claim 4. Examiner further submits that Challener et al discloses the subject matter recited in the italics above. Challener discloses receiving a message at a server sent from the computer system, the message including the service tag in the form of a log-in token that uniquely identifies the client computer (Col. 3, lines 5-10; Col. 6, lines 1-15); verifying that the service tag value as received matches a service tag value or log-in token stored in the server (Col. 3, lines 9-24; Col. 6, lines 40-45; Col. 6 line 61-Col. 7 line 5) and authorizing receipt of a benefit if the received service tag matches (Col. 3, lines 9-24; Col. 6, lines 40-45; Col. 6 line 61-Col. 7 line 5). The reference to Colligan et al was merely used to show that it was known to store a unique computer identifier in the memory of a computer during assembly and to use this identifier to access some benefit. In response to applicant's argument that Colligan et al and Challener et al are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be

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relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Challener et al and Colligan et al are reasonably pertinent to the particular problem with which the applicant was concerned since they both relate to accessing a benefit based on the identification of a client computer. Challener et al uses a log-in token to identify the client computer and Colligan et al uses a service tag to identify the computer and examiner submits that one having ordinary skill in the art would look to other methods for identifying a client computer such as that taught by Colligan et al. Examiner submits that it would have been obvious to one having ordinary skill in the art to modify the teachings of Challener et al and utilize a service tag to identify the client computer instead of the log-in token as taught by Challener et al. Furthermore, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

5. With respect to claim 11, applicant argues that the references fail to disclose sending the service tag to a remote server to verify the purchase of a benefit. Examiner respectfully disagrees and submits that Challener et al disclose this feature (Col. 3, lines 5-10; Col. 6, lines 1-5). The log-in token transmitted to the remote server is used to verify purchase of a benefit such as access to Internet service or access to warranty service.

6. With respect to claim 14, applicant argues that the references fail to disclose the valid service tag corresponding to computer systems that purchased a benefit. Examiner respectfully disagrees and submits that Challener et al, as discussed above, disclose the storage of valid service tags in the form of preregistered log-in tokens which are used to approve the utilization of a service such as access to Internet service or access to warranty service.

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Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 14 and 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Challener et al, U.S. Patent No. 6,654,886 B1.

As per **Claim 1**, Challener et al discloses a method for purchase verification, comprising the acts of:

- receiving at a server a first message from a computer system, the first message including a service tag, the service tag uniquely identifying the computer system (Col. 3, lines 5-25; Col. 5, lines 64-65; Col. 6, lines 10-20);
- determining at the server if the service tag is valid (Col. 3, lines 9-15; Col. 6, lines 10-25; Col. 6 line 62-Col. 7 line 1); and
- generating a second message from the server, the second message authorizing providing a benefit if the service tag is determined to be valid (Col. 7, lines 1-5).

As per **Claim 14**, Challener et al disclose a system for purchase verification, the system being on a server platform (Figure 1), the server operated by a service provider (Col. 3, lines 20-25), the server configured to communicate with a purchased computer system (Figure 1), the server including a processor and a memory, the server platform configured to communicate with a remote computer system (Figure 1), the system comprising:

- a non-volatile computer readable memory, the non-volatile computer readable memory storing:

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- a database, the database including a set of valid service tags, the valid service tags corresponding to computer systems that purchased a benefit (Col. 3, lines 1-13; Col. 6, lines 1-15); and
- instructions, executable on the processor, configured to receive a message, the message including a service tag, the service tag uniquely identifying a computer system (Col. 3, lines 5-25; Col. 6, lines 1-5).

As per **Claim 15**, Challener et al further disclose that the message includes a product code such as a service (Col. 1, lines 35-55; Col. 2 line 63-Col. 3 line 6; Col. 3, lines 20-25).

As per **Claim 16**, Challener et al further disclose instructions, executable on the processor, configured to authorize a purchaser to receive a benefit (Col. 3, lines 9-24; Col. 6, lines 40-45; Col. 6 line 61-Col. 7 line 5).

As per **Claim 17**, Challener et al further disclose instructions executable on the processor, configured to verify the service tag, wherein the instructions to verify the service tag further comprise:

- instructions to receive the service tag from the computer system (Col. 3, lines 5-10; Col. 6, lines 1-5 and 35-40);
 - instructions to recall the service tag stored in the server (Col. 3, lines 7-14; Col. 6, lines 10-16);
- and
- instructions to compare the service tag received from the computer system to the service tag recalled from the server to determine if the service tag received from the computer system matches the service tag recalled from the server (Col. 3, lines 7-20; Col. 6 line 62-Col. 7 line 10).

As per **Claim 18**, Challener et al further disclose instructions, executable on the processor, configured to authorize a purchaser to receive a benefit if the service tag received from the computer system matches the service tag recalled from the server (Col. 3, lines 7-20; Col. 6 line 62-Col. 7 line 10).

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As per **Claim 19**, Challenger et al further disclose instructions, executable on the processor, configured to establish an internet service provider service account if the service tag received from the computer system matches the service tag recalled from the server (Col. 3, lines 20-25).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2-3 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Challenger et al, U.S. Patent No. 6,654,886.

As per **Claims 2 and 10**, Challenger et al fail to specifically disclose invalidating the service tag after generating the second message. However, takes official notice that invalidating access to a service when it has been depleted was well known in the art at the time of applicant's invention. Challenger et al describes that the service being accessed by the client may be any type of service for which access needs to be controlled (Col. 3, lines 20-25). Examiner submits that it was known in the art to invalidate a token or other identifier after the client no longer met the requirements for access. Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Challenger et al and invalidate the client's log-in token in cases where the client has accessed a one time service or has otherwise depleted the allowed access. The motivation would be to ensure that the service tag or token cannot be used again and thereby reduce the possibility of fraud.

As per **Claims 3 and 9**, Challenger et al further disclose that the message includes a product code such as a service (Col. 1, lines 35-55; Col. 2 line 63-Col. 3 line 6; Col. 3, lines 20-25).

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As per **Claim 8**, Challener et al disclose a method for purchase verification, comprising the acts of:

- receiving a first message at a first server, the first message being sent from a computer system, the first message including a service tag, the service tag uniquely identifying a computer system (Col. 3, lines 5-25; Col. 5, lines 64-65Col. 6, lines 10-20); and

- transmitting a message allowing access to the benefit (Col. 7, lines 1-5).

Challener et al, however, fails to explicitly disclose transmitting a second message from the first server to a second server, the second server attempting to verify the validity of the service tag. Examiner takes official notice that using a second server or even a third party server for validating tokens or other items used for identification purposes was well known in the art at the time of applicant's invention. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Challener et al and include using a second server for the specific purpose of validating a token or other item used for identification purposes. One would have been motivated to use a second server for validation procedures in order to reduce the necessary processing conducted by the primary server.

As per **Claim 20**, Challener et al fail to specifically disclose invalidating the service tag after generating the second message. However, takes official notice that invalidating access to a service when it has been depleted was well known in the art at the time of applicant's invention. Challener et al describes that the service being accessed by the client may be any type of service for which access needs to be controlled (Col. 3, lines 20-25). Examiner submits that it was known in the art to invalidate a token or other identifier after the client no longer met the requirements for access. Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Challener et al and invalidate the client's log-in token in cases where the client has accessed a one time service or has otherwise depleted the allowed access. The motivation would be to ensure that the service tag or token cannot be used again and thereby reduce the possibility of fraud.

11. Claims 4-7 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Challener et al, U.S. Patent No. 5,654,886 B1 in view of Colligan et al, GB 2339488 A, published 26 January 2000.

As per **Claims 4-5**, Challener et al disclose a method for purchase verification, comprising the acts of:

- generating a service tag that uniquely identifies a computer system, the computer system including a processor coupled to a memory (Figure 2; Col. 3, lines 7-24; Col. 5, lines 45-50 and 60-65);
- receiving a message at a server sent from the computer system, the message including the service tag (Col. 3, lines 5-10; Col. 6, lines 1-5);
- verifying that the service tag value as received matches a service tag value stored in the server (Col. 3, lines 9-24; Col. 6, lines 40-45; Col. 6 line 61-Col. 7 line 5);
- authorizing receipt of a benefit if the received service tag matches (Col. 3, lines 9-24; Col. 6, lines 40-45; Col. 6 line 61-Col. 7 line 5).

Challener et al, however fail to explicitly disclose storing the service tag in the memory at assembly of the computer system. Colligan et al disclose a system for downloading custom software to a unique computer and only authorizes the software to be downloaded if the computer is identified by the correct unique service tag (Page 4, lines 15-24; Page 5, lines 5-13; Page 9, lines 15-17; Page 10, lines 1-11). Colligan et al further disclose that the unique identifier for the specific computer is known as a service tag and is "burned" into a hidden section of non volatile memory such as the BIOS within the computer during the manufacturing process of the computer (Page 10, lines 6-11; Page 13, lines 7-22). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Challener et al and utilize a unique identifier or service tag which is burned into non-volatile memory in order to uniquely identify the computer requesting services as taught by Colligan. One would have been motivated to use this type of identifier since it is an effective means for uniquely identifying a specific computer to ensure that the identified computer is the one authorized to receive any type of service, access or software download.

As per **Claim 6**, Challener et al further disclose generating a second message, the message authorizing a purchaser to receive the benefit, if the service tag matches (Col. 3, lines 10-13; Col. 6, lines 40-45; Col. 6 line 61-Col. 7 line 5).

As per **Claim 7**, Challener et al further disclose wherein the benefit is Internet Service Provider service (Col. 3, lines 20-25).

As per **Claim 11**, Challener et al disclose a system, the computer system including a processor (Figure 2), the system comprising:

- a non-volatile computer readable memory (Figure 2), the non-volatile computer readable memory including:

- instructions, executable on the processor, configured to store a service tag to uniquely identify the computer (Figure 2; Col. 3, lines 7-24; Col. 5, lines 45-50 and 60-65);

- instructions, executable on the processor, configured to send the service tag to a remote server (Col. 3, lines 5-10; Col. 6, lines 1-5).

Challener et al, however fail to explicitly disclose storing the service tag in the memory at assembly of the computer system. Colligan et al disclose a system for downloading custom software to a unique computer and only authorizes the software to be downloaded if the computer is identified by the correct unique service tag (Page 4, lines 15-24; Page 5, lines 5-13; Page 9, lines 15-17; Page 10, lines 1-11). Colligan et al further disclose that the unique identifier for the specific computer is known as a service tag and is "burned" into a hidden section of non volatile memory such as the BIOS within the computer during the manufacturing process of the computer (Page 10, lines 6-11; Page 13, lines 7-22). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Challener et al and utilize a unique identifier or service tag which is burned into non-volatile memory in order to uniquely identify the computer requesting services as taught by Colligan. One would have been motivated to use this type of identifier since it is an effective means for uniquely identifying a specific computer to ensure that the identified computer is the one authorized to receive any type of service, access or software download.

As per **Claim 12**, Challener et al further disclose that the message includes a product code such as a service (Col. 1, lines 35-55; Col. 2 line 63-Col. 3 line 6; Col. 3, lines 20-25).

As per **Claim 13**, Challenger et al, however, fails to explicitly disclose communicating with a remote server, the server having the ability to verify the service tag. Examiner takes official notice that using a second server or even a third party server for validating tokens or other items used for identification purposes was well known in the art at the time of applicant's invention. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Challenger et al and include using a second server for the specific purpose of validating a token or other item used for identification purposes. One would have been motivated to use a second server for validation procedures in order to reduce the necessary processing conducted by the primary server.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of

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the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Geiger et al disclose a method of conducting transactions by generating product certificates and license certificates and installing these certificate in a wireless phone at the factory. The certificates are validated by a validation service in order to allow the user to use the service or product.
- Springer discloses the use of a service tag to allow access to online services
- Boede et al disclose a built-in automatic customer identifier when connecting to a vendor website
- Toader discloses a method for providing on-line support using pre-paid internet access

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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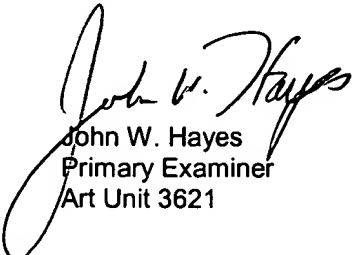
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington,
VA, 7th floor receptionist.


John W. Hayes
Primary Examiner
Art Unit 3621

January 4, 2005